

REMARKS

Claims 1, 3-12, and 15-19 are currently pending in the application. Applicants have canceled claims 2 and 13-14, amended claims 1, 3-4, 8, 10, 11, and 15, and added claims 18-19. Applicants request reconsideration of the application in light of the following remarks.

Telephone Interview

Applicant's attorney wishes to thank the Examiner for his courtesy and time during a telephone interview that was held on January 11, 2005. The Examiner's comments and insight were very helpful in preparing this response. It is hoped that the comments below reflect the spirit of the interview.

In summary, Applicants' representative pointed out the need to provide the Applicant with the best possible coverage and avoid design around. Applicants' representative explained how the combination of Williams with Canfield would make the sleeve of Canfield inoperable, and would close the second opening through a bottom thereof. Thus, the claimed combination of features overcomes the art relied upon.

The Examiner gave feedback on addition of "method of using" claims, and stated that he would restrict them if presented herein.

AMENDMENT TO THE SPECIFICATION

The specification has been amended to support the term "girth" as applied to features shown in the Figures and now used in the specification to better define the invention. The sleeve 11 of the present invention has at least two generally circumferential dimensions, as shown in the figures, and so supports the terms "first girth" and "second girth" since the definition of "girth" is: the measure around anything; circumference, (Webster's Encyclopedic Unabridged Dictionary, published by Gramercy Books, Copyright 1996). Since the features to which the term "girth" has been applied by this amendment were

originally shown in the drawings and described in the specification, no new matter has been added. Alternatively stated, the term “girth” simply and aptly describes features that were shown and described in the specification. Therefore, addition of this term does not add new matter.

Rejections under 35 U.S.C. §103

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants’ disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims

Claims 1-17 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Canfield (U.S. Patent No. 6,464,100, hereinafter “Canfield”), in light of Williams (U.S. Patent No. 6,123,220, hereinafter “Williams”) and Chauhan et al. (U.S. Patent No. 6,554,154, hereinafter “Chauhan”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

With regard to claim 1, Applicants have amended the claim to include “first and second inwardly extending annular gripping members on an interior of the sleeve configured for defining a volume of air between the gripping members”. In addition, claim 1 recites “an insulating sleeve” having first and second ends with respective first and second openings. Still further, claim 1 requires “a plurality of suction cups affixed to the sleeve”.

Firstly, it is pointed out that neither Williams nor Chauhan have an “insulating sleeve”. The insulating feature of the present invention is provided by the “first and second inwardly extending annular gripping members on the interior of the sleeve”. Contrary to this, Canfield has an insulating sleeve that is insulative only by nature of the material. Canfield provides no need or motivation for “inwardly extending annular gripping members” so that the motivation would apparently have to be provided by Chouhan relied upon for “ribs”. It is pointed out that the “reinforcing ribs” of Chouhan are not “inwardly extending annular gripping members” as now recited in claim 1. Furthermore, there appears to be no motivation to combine the reinforcing ribs of Chauhan on the sleeve of Canfield because Canfield achieves increased strength and other desired advantages through providing the sleeve of a greater thickness as set forth in column 2, line 64 to column 3, line 1.

Secondly, providing the suction cups as taught by Williams on the sleeve of Canfield would destroy the reference to Canfield. Williams applies suction cups integrally with a disc-like substrate 24 as shown in Figures 3 and 5 of Williams. Fixing this disc-like substrate 24 on a bottom of the sleeve 10 of Canfield would destroy the reference to Canfield. One reason is that doing so would close the second opening of the second end of the sleeve of Canfield. This, in turn, would limit the expandability of the sleeve 10 of Canfield, which is a material aspect of Canfield’s invention. Furthermore, closing the second opening in this way causes that the combination of references no longer provides the second opening as recited in claim 1. Therefore, the combination of Canfield, Williams, and Chauhan fail to provide the invention of claim 1 on several counts and withdrawal of the rejection is respectfully requested.

Claims 2 and 13-14 have been canceled. Therefore, the rejection of these claims has been obviated.

Claims 3-9 are considered to be allowable as depending from an allowable base claim and for further patentable details therein as may be appreciated by the Examiner. For example claim 3 recites that the “annular gripping members sealingly engage the container”,

unlike any of the references relied upon, and claim 8 adds the structural details of the flange on the second end of the sleeve and structure thereon for receiving the suction cups.

Claim 10 recites that the sleeve has an “inwardly extending rib ... formed integrally with said sleeve and configured for sealingly engaging an outer surface of a beverage container”. The inwardly extending rib has a second girth smaller than a first girth of a main portion 12 of the interior surface of the sleeve 11. The first girth greater than the second girth as shown in Figures 4-6. The larger first girth forms a bounded volume of air when a drink container is received in the sleeve. This volume of air is defined and sealed off in part by the inwardly extending rib and acts as an insulator. None of the references relied upon has these features. Hence, the plurality of suction cups of Williams is insufficient in meeting claim 10 by its combination with the other references. Furthermore, there is no motivation to combine Williams with the other references as set forth in the response to the rejection of claim 1 above. Therefore, Applicants respectfully request that the rejection of claim 10 be withdrawn, and that claim 10 be allowed.

Claims 11-12, and 15-17 are considered to be allowable as depending from an allowable base claim and for further patentable details therein as may be appreciated by the Examiner.

Applicants respectfully request that the obviousness rejections of all of claims 1, 3-12, and 15-19 be withdrawn, and these claims be allowed.

New Claims

Claim 18 recites the “inwardly extending flange” that bounds the second hole and “the plurality of suction cups affixed to the inwardly extending flange” in addition to the structure defined in claim 10 that is considered to be patentable as set forth above. Nowhere in the art does there appear to an insulating receptacle that has a sleeve with an inwardly extending rib configured for sealingly engaging an outer surface of a beverage container, a main portion of the sleeve having a girth larger than a girth of the inwardly extending rib, an inwardly

extending flange on the sleeve, and a plurality of suction cups on the inwardly extending flange as now required by claim 18. Therefore, allowance of claim 18 is earnestly solicited.

Claim 19 recites a range in the number of suction cups to be placed on the sleeve. Examples of specific numbers of suction cups are shown in the Figures. For example Figure 3 shows eight suction cups. Figure 6 teaches the addition of two more suction cups. However, a range including, but not limited to the specific examples shown in the Figures is supported by the specification. That is, the range of eight to ten is supported in the specification since “a plurality” is defined as “two” or more. In reality, the specification supports a lower end of the range at “two” suction cups and an upper end of the range may be any number of suction cups more than two since “a plurality” is only limited on its lower end. Therefore, “a plurality” includes three, four, ... eight, ..., ten, ... fifteen, sixteen, and more numbers. This interpretation is in keeping with the the MPEP, which explicitly states that Applicant is not to be limited from claiming his invention in the broadest possible way. Thus, “a plurality” is considered to support each and every number greater than or equal to “two”. Therefore, a range of eight to ten suction cups as recited in claim 19 properly narrows the claimed invention and requires a range not shown in the references relied upon.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

CONCLUSION

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.


The amendments herein canceled 3 dependent claims, and added 2 new dependent claims. Therefore, no fees are due.

It is requested that a one-month extension of time be granted for the filing of this response, and the appropriate extension filing fee of \$60 is enclosed herewith.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

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